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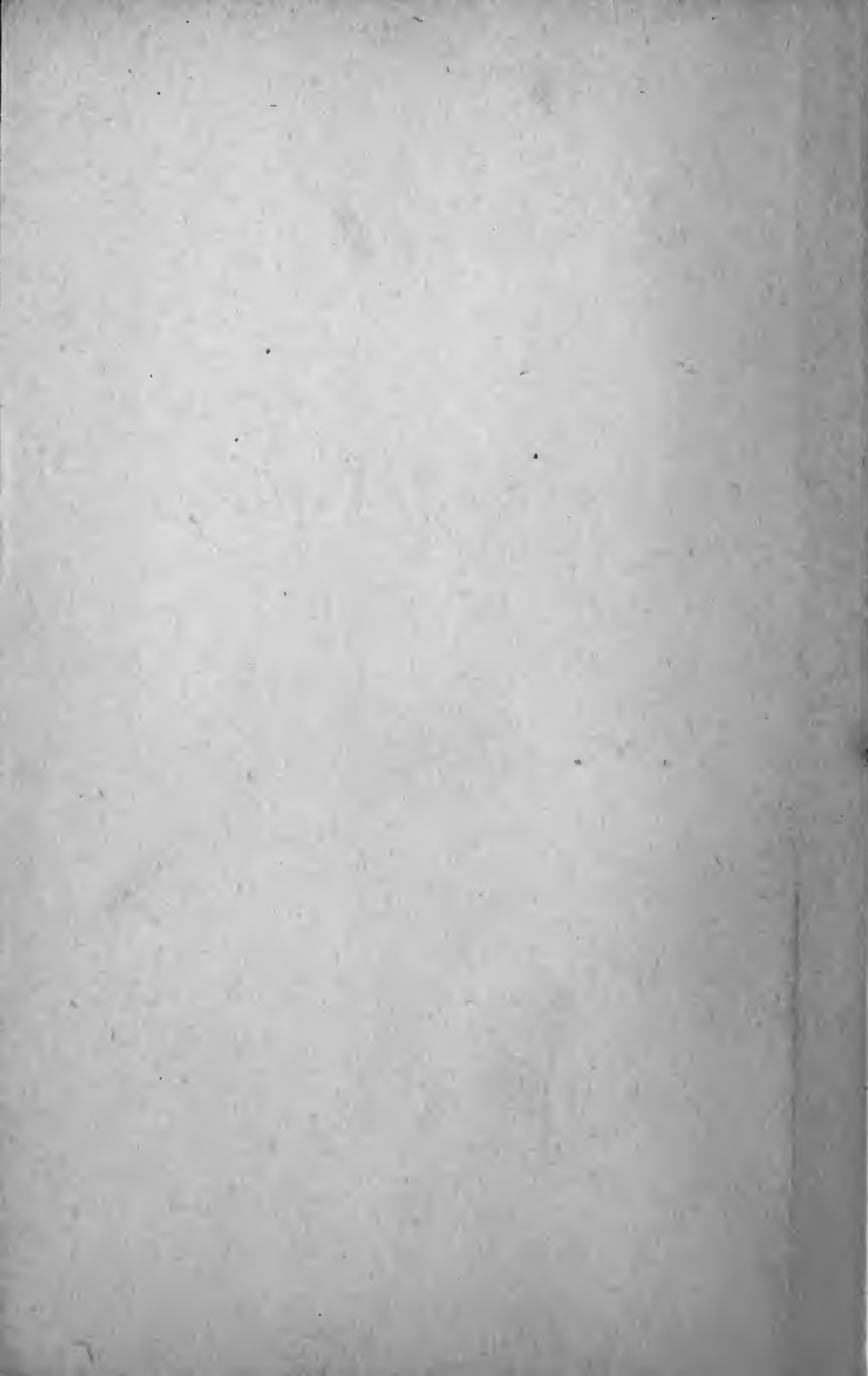
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UNITED STATES OF AMERICA.



A BRIEF HISTORY
OF
PATENT LEGISLATION
IN THE
UNITED STATES





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IN
THE UNITED STATES.

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A BRIEF HISTORY OF PATENT LEGISLATION IN THE UNITED STATES.

THE ENGLISH PRECEDENT.—The English Colonists to America brought with them familiarity with the idea of fostering manufactures by the grant of exclusive privileges in Patents from the Crown to inventors or first introducers. In the Statute of 1623, in the reign of James I., directed against grants of monopolies, there was an express exception in favor of Patents and Grants of Privilege “for the sole working or making of any manner of new manufacture within the realm, *to the first and true inventor or inventors of such manufactures, which others at the time of making such Letters Patents, and Grants shall not use, so they be not contrary to law or mischievous to the State, by raising the price of commodities at home, or hurt of trade, or generally inconvenient.*” In the italicized words is the principle of the great structure which Congress and the courts have raised in the Patent System of the United States. The Colonists, with their remarkable power of adapting legal ideas and forms to the new conditions of life into which they came, even before the Constitution, began in the laws of certain of the Colonies to develop an American Patent System, and the utility to the State of patent protection to arts and manufactures was recognized in the Constitution in the clause conferring upon Congress power to “promote the progress of science and the useful arts by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries.” Out of the power conferred by this clause has proceeded the legislation to be immediately briefly summarized.

THE PATENT ACTS.

THE ACT OF 1790.—The first Patent Act, under the Constitution, was approved April 10, 1790, less than a year after the inauguration into the Presidency of General Washington. It provided for the granting of Letters Patent, which should secure to "the patentee, his heirs and assigns, for fourteen years, the exclusive privilege of making, constructing, using and vending to others to be used," the thing patented. The patent was to be issued on a petition to the Secretary of State, the Secretary for the Department of War and the Attorney General, setting forth that the "petitioner had invented or discovered a useful art, manufacture, engine, machine or device, or any improvement therein, not before known or used," and praying that a Patent might be granted therefor. A specification in writing was required to be delivered to the Secretary of State, "containing a description, accompanied by drafts or models, and explanations and models (if the nature of the invention or discovery admitted of a model) of the thing invented or discovered," and this specification was required to be so "particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman, or other person skilled in the art of manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct and use the same, to the end that the public may have the full benefit thereof after the expiration of the patent term."

The italicized parts present most clearly the doctrine on which the patent laws of the United States are founded, and the nature of the contract impliedly existing between the inventor or patentee and the Government. The latter throws around the former, for a certain time, the protection of its sovereignty, in securing to him an exclusive privilege, in return for which protection, and as a condition of its grant, the inventor is required to file with the Government the full and complete directions

necessary to inform the people how they may make and freely use the invention after the expiration of the patent term.

The Statute also contained provisions for bringing infringement suits and for recovery of damages, and the defendant was authorized to plead the general issue and introduce proof to show that the patentee was not the first inventor, that "the specification did not contain all that was necessary for making or using the invention, or more than was necessary, and that the additional parts were misleading so as to prevent the obtaining of the result described in the specification." Proof of any of these things voided the patent. Suits were also allowed to be brought for annulling a patent on the ground that it had been obtained "surreptitiously or by false suggestion."

The scale of fees seems curious to-day—viz.: For receiving and filing the petition, 50 cents ; for filing the specification, per copy sheet containing one hundred words, 10 cents ; for making out patent, \$2 ; for affixing the great seal of the United States, \$1 ; for indorsing the day of delivering the same to the patentee, including all intermediate services, 20 cents.

This early act containing the fundamental principles of subsequent legislation, the later laws will be more briefly noted in those particulars wherein they differ from their predecessors.

THE ACT OF 1793.—The Act of 1790 had provided for the granting of patents to any person without reference to nationality. That of 1793 restricted the grant to citizens of the United States, and directed the petition to be presented to the Secretary of State alone. This Statute also first provided, as a condition of grant of patent, that the inventor should make *oath or affirmation* that "he verily believed himself to be the true inventor or discoverer of the art, machine, or improvement for which he solicited a patent. *Written references to drawings* were also first required by this act, which further provided that the inventor of *an improvement* (which was patented) of a machine or process, before

patented, might not make, use, or vend the original discovery, nor should the first inventor have right to use the improvement ; and *simple change of form or proportions* of a machine or composition of matter was declared not to be a discovery in the sense of the Statute. Provision was made for *assigning inventions* and for *recording assignments* in the office of the Secretary of State, and also for a *Board of Three Arbitrators* to consider *interfering applications* and determine to which applicant a patent should be granted. *The fee* for obtaining a patent was fixed at \$30.

THE ACT OF 1794.—As the Act of 1793 repealed that of 1790, in 1794 a law was enacted providing for the continuance of suits which had been begun under the Act of 1790.

THE ACT OF 1800.—The right to obtain a patent was, by this act, extended to *aliens*, who had, at the time of their petition, resided for two years in the United States, and such aliens were required to make oath, or affirmation, that “to the best of their knowledge or belief, such invention, art, or discovery had not been known or used, either in this *or any foreign* country.” By this act, also, was provision first expressly made for the granting of patents to the *legal representatives* of inventors who had died before obtaining patents.

THE ACT OF 1819.—Original cognizance, as well in equity as at law, was, by this act, secured to the Circuit Courts of the United States in all actions arising under the patent and copy-right laws.

THE ACT OF JULY 3, 1832.—Here, for the first time, is express authority given for the *extension* and *reissue* of patents. It was enacted that petitions for extensions of patents should be made to Congress before the expiration of the term of the patent, together with a statement, verified under oath, of the value of, and receipts and expenditures under, the patent. A *reissue* of a pat-

ent might be made by the Secretary of State, upon surrender to him of such patent, when a patent was "invalid or inoperative by reason that any of the terms or conditions relating to the sufficiency of the specification and drawings, of the act of 1793" (substantially the same as the provisions of the Act of 1790) "had not by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with." The reissue was to take the place, in all respects, of the original patent, and be valid for the unexpired term. The act also provided for the publication in January of each year of lists of all patents which had expired during the year preceding.

Reissues, formally recognized by this act, had been previously granted by the Secretary of State, and had been sustained by the Supreme Court, John Marshall delivering the opinion in one of the cases. In accordance with these decisions the Act of 1832 was drawn, and the reissue of patents continues lawful to the present time. But inventors and their assignees abused the privilege, and the Supreme Court has recently rendered decisions which will hereafter prevent the obtaining of reissues for the purpose for which they are usually sought, viz., to broaden claims after the original patent has been found incapable of securing to its owners wide protection. A brief discussion of this matter will be made hereafter.

THE ACT OF JULY, 13, 1832.—The right to obtain a patent is now extended to every *alien*, who at the time of his petition is a resident of the United States, and has declared his intention to become a citizen, without regard to the time during which he may have resided in the country. But every patent granted by virtue of the act becomes void on the "failure of the patentee, for the space of one year, from the issue of the patent, to *introduce into public use in the United States*, the invention; or if the invention for the period of six months after such introduction shall not continue to be publicly used and applied in the United States; or in

case of *failure to become a citizen* at the earliest period at which the patentee shall be entitled so to become."

THE ACT OF 1836.—By this act were first created a *Patent Office, Commissioner of Patents, and Seal of the Office*. The Patent Office was attached to the Department of State, and the Commissioner, appointed as now by the President, by and with the advice of the Senate, received authority to perform, under direction of the Secretary of State, all duties relating to the granting of patents. The proper subject matter of patents was defined as follows: "Any person * * * having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, *not known or used by others before his or their discovery or invention thereof, and not at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer* * * * the Commissioner may grant a patent therefor." In this act first appears the requirement that the inventor shall specifically *claim* the part, improvement, or combination, which he desired to cover by the patent. Authority was also given to *date back* a patent to the *date of filing the specification and drawings*, provided the date of filing was not more than six months prior to the actual issue, and an inventor was not to be deprived of his right to a patent by reason of his having *previously taken out a foreign patent*, if such foreign patent had been published within six months of the date of filing the application in the United States. *Examinations* into the state of the art were by this act first directed to be made, and the *citing of references* to the applicant, as to what appeared to anticipate his invention, was also first specifically provided for. A *Board of Examiners*, three in number, and to be appointed by the Secretary of State, was created to hear appeals from decisions of the Commissioner on the matter of anticipation. The *appeal* fee was fixed at \$25, and in order to

obtain the right of appeal, the applicant was required to *renew his oath of invention*. Procedure in cases of interference was more carefully defined than hitherto, and remedy by *bill in equity* was provided in cases of interfering patents, or when an applicant had been refused a patent on the ground that the granting of his application would interfere with an unexpired patent. *Caveats* were also first provided for by this act. The caveat was to be filed in the confidential archives of the office, and secured to the caveator for a year the right to be informed of any subsequent application with which his caveat would interfere, and to have three months from the time of such notice in which to file his complete application for a patent. The *fee* for a caveat was \$20, which sum might be applied to pay the fees of the subsequent taking out of the patent. *Specifications of subsequent improvements* made by the original inventor might be *added* to the original description and specification, and have thereafter the same effect in law as though the improvement had been embraced in the original patent. Extensions were directed to be made on application to the Commissioner, and under direction of the Secretary of State, the Commissioner of Patents, and the Solicitor of the Treasury. The fee, on applying for an extension, was to be \$40. In infringement suits, the fact that the invention had been before *known or used in a foreign country, it not having been patented or described in any printed publication* was not to void a patent; but the "*failure of the patentee, if an alien, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery,*" was to void the patent. The fees were fixed in the act, as follows: For citizens of the United States, and for aliens who had declared their intention of becoming citizens, \$30; for subjects of the King of Great Britain, \$500; for all other persons, \$300.

This act also made provision for a patent library, and an exhibition of models and specimens.

THE ACT OF 1837.—On December 15, 1836, the Patent Office Building was burned. On March 3, 1837, an act was passed providing for the re-collection, as far as possible, of the patents, specifications, drawings, and models, which had been destroyed. Provision was also made in the act for the *re-issue of patents in several sections*, in place of a single original, and for the *issue of a patent to the assignee of the inventor*. Disclaimers were now first specifically named, and it was provided that when a patentee had innocently claimed more than he had invented, his patent yet should be valid for so much as he had invented. For the first time, also, appears the proviso that in every such case costs could not be recovered from a defendant, unless the plaintiff had entered the proper disclaimer in the Patent Office, prior to the commencement of the suit.

THE ACT OF 1839.—The cursory provision in the Act of 1836, that an inventor's having taken out a foreign patent should not *per se* deprive him of the right of obtaining a United States patent, was repeated more definitely and the privilege extended in this act, by a clause to the effect that "no person should be debarred from receiving a patent * * by reason of the invention having been patented in a foreign country more than six months prior to his application ; provided the invention had not been introduced into public and common use in the United States prior to the application for such patent." A patent, so taken, was to be limited to a term of *fourteen years from the date of publication of the foreign patent*. One who had purchased or made, *before application for patent by the inventor*, a newly invented machine, manufacture, or composition of matter, was secured in his right to *make, use, and sell that specific thing*, even after the inventor obtained a patent ; and such purchase, sale, or use of the invention was not to invalidate the patent, unless it had been for *more than two years prior to the application*, except on proof of abandonment of the invention to the public. Here we find the first definite

statement that two years public use of an invention, before application for patent, is allowable without invalidating the patent. The remedy by *bill in equity* was extended to *all cases* where patents were refused either by the Commissioner or the Chief Justice of the District of Columbia, and where *appeals* were previously allowed from the Commissioner to the Board of Examiners, such appeals, were by this act, to be taken to the Chief Justice of the District Court for the District of Columbia.

THE ACT OF 1842.—*Patents for Designs* were first, by this act, expressly provided for, the procedure for obtaining such patents defined, the *term* fixed at *seven years*, and the *fee* at *one-half* that required for mechanical patents. Any citizen, or an alien who had resided one year in the United States and taken oath of intention to become a citizen, might obtain a design patent. By this act, for the first time were *patented articles required to be marked with the date of the patent*, and severe penalties were imposed for failure so to do. Also for the first time, were *others than owners* of rights under patents, *forbidden* (under penalties) *to mark* patented articles with words "*patent*," "*patentee*," etc.

THE ACT OF 1848.—*The power of extending patents*, previously vested in a board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, was by this act conferred upon the *Commissioner alone*, and proceedings defined. The *fee for recording assignments*, which had been variously fixed by preceding laws, was now settled at the present rates—viz., for not more than 300 words, \$1; for from 300 to 1,000 words, \$2; and for more than 1,000 words, \$3.

THE ACT OF 1849.—The second section of this act placed the Patent Office under the supervision of the newly created *Secretary of the Interior*.

THE ACT OF 1852.—By this act *appeals* from the Commissioner of Patents were allowed to be taken to the *assistant judges* of the *Circuit Court of the District of Columbia*, as well as to the Chief Judge.

THE ACT OF FEBRUARY 18, 1861.—By this act appeals from all judgments of the Circuit Courts in cases arising under the patent and copyright laws were made permissible to the Supreme Court of the United States, without regard to the sum in controversy.

THE ACT OF MARCH 2, 1861.—The *term* of patents granted subsequent to this act was fixed at *seventeen years*, and *all extensions of such patents* were forbidden. The *fees* were fixed at the present rate—viz., on filing an application, \$15; on issuing the patent, \$20. The *terms of design patents* were fixed as they still remain—viz., three years and six months; seven years, and fourteen years, at the selection of the applicant; and design patents were capable of *seven years extensions*. The fees were fixed at \$10, \$15, and \$30, according to the length of the term. The provision of the Act of 1836, permitting *specifications of improvements* to be added to the original patent, was repealed, and for such improvements *independent patents* were required, as is the present practice. The permanent Board of Three *Examiners-in-Chief*, was first provided for by this law, to hear appeals from the primary examiners and the examiners in interferences. From their decision *appeal* was directed to the *Commissioner in person*, as is the present practice; and to obtain right of appeal to the Examiners-in-Chief an application must have been *twice* examined and *rejected* by the primary examiner as is still the law, while to obtain the second examination, the inventor was required to *renew his oath*. Such renewal is not now required. It was provided that *failure to mark* patented articles with the word "patented" and date of patent should *prevent the recovery of damages* in an infringe-

ment action, unless proof were given that the defendant had continued his infringement after due notice thereof. *The penalties* for failure to so mark, fixed by the Act of 1842, were repealed.

THE ACTS OF 1862, 1863, 1864, 1865, 1866.—Most important in these acts was the provision, first appearing in the Act of 1863, that if the *final fee* were not paid within *six months* of the date of allowance of the patent, the patent should be *withheld* and the invention should *become public property*, as against the applicant. This was amended by the Act of 1864, to permit any person having an interest in such invention, as inventor or assignee, to pay the final fee within six months of the date of passage of this act, and receive the patent ; but no person was to be held responsible in damages for manufacture or use of such invention in the meantime. By the Act of 1865, either the inventor or the assignee obtained the right to make application for a patent within two years of the date of allowance. There was the same proviso as to damages as in the Act of 1864. By the Act of 1866, the *fee* for the *appeal* from the decision of the primary examiner to the Examiners-in-Chief was fixed at \$10.

Thus, in brief resumé, we have followed the patent legislation of the United States from the earliest law down to the Consolidated Patent Act of 1870, which gathered into one comprehensive measure the substance of preceding legislation and court decisions. This act repealed all earlier laws, was itself slightly amended in 1871, and was substantially incorporated into the "Revised Statutes" of 1874, which, with some few additions, are the law to-day. The resumé thus given has indicated the growth of the system to the form it now has, all of the essential features of our present statutes having been developed prior to the passage of the Act of 1870. For this reason, and because of the great bulk of the provisions of the Revised Statutes relating to patents, I shall only quote from them a few sections, indicating who may obtain patents and what constitutes patentable subject matter.

THE REVISED STATUTES.—Any person, whether a citizen or an alien, may obtain patent protection for the term of seventeen years, who has invented or discovered any *new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned.*" The fact that the invention has been first patented in a foreign country will not debar the inventor from obtaining a valid patent in the United States, unless the same has been here "*introduced into public use for more than two years prior to the application.*" But the patent will expire with that foreign patent having the *shortest term.*

Application (petition), must be made in writing to the Commissioner of Patents, and a written description of the invention, with drawings, must be filed in the Patent Office, "in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it relates, or with which it is most nearly connected, to make, construct, compound, and use the same." "The applicant must make *oath* that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, for which he solicits a patent ; that he does not know and does not believe that the same was ever before known or used ; and shall state of what country he is a citizen." *Distinct claims* shall be made to the "part, improvement, or combination which he claims as his discovery."

If the *final fee* is not paid within six months from the time the application was passed and allowed "the patent shall be withheld." But any person "who has an interest in an invention or discovery, for which a patent was ordered to issue, * * * but who fails to make payment of final fee within the six months, shall have a right to make an application for a patent for such invention or

discovery any time within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent." A person who purchases of the inventor, or with his knowledge and consent constructs any newly invented patentable article, or who sells or uses one so constructed, prior to the application by the inventor or discoverer for a patent, shall have the right to use and to vend to be used the specific thing so made or purchased.

Patented articles are required to be marked by the owners of the patent with the word "patented" and date of the patent. If the article is not so marked damages cannot be recovered in an infringement suit, except on proof that the defendant was duly notified of the infringement, and thereafter continued to make, use, or vend the patented article. Penalties are imposed on those, who, without authority, mark articles with the word "patent," etc., or with any imitation of the name of the true patentee.

Caveats are granted to citizens of the United States, or to aliens who have resided for one year in the United States and have made oath of intention to become citizens. The fee for a caveat is \$10; its protection lasts for one year, and the caveator is entitled to notice of the filing of any subsequent application with which his caveat would interfere. He is given three months after such notice in which to complete his application and file his specification and drawings.

Design patents are granted to both citizens and aliens for the terms of three years and six months, seven years and fourteen years, as the applicant elects.

Fees : On filing each original application for a mechanical or process patent, \$15; on issuing each such original patent, \$20; for design patents, \$10, \$15, and \$30, according to the length of the term.

FIRST DRAUGHTS AND REISSUES.

Subsequent to the Act of 1832 it became the practice of inventors and owners of inventions to take out the original patents with little care, and afterward, when the patent had become valuable, to obtain *reissues* with claims so broadened as to give adequate protection to the owners of the patent. The privilege was abused, and converted into a means of forcing out of the field inventions which had sprung up between the date of the original grant and the reissue. The matter attracted the attention of the Circuit Courts in many cases, and finally the Supreme Court prevented the continuance of the practice by several very important decisions, especially that in the case known as *Miller & Co. vs. Bridgeport Brass Co.* The effect of these decisions is that a patentee can not now obtain a *reissue for the purpose of broadening the claims of his patents*. Even if the original invention was justly entitled to the full benefit of the broad claims afterwards sought to be incorporated into the reissue, yet such a *valid* reissue can not be granted. Further, the Commissioner of Patents conforms the practice of the Patent Office to the decisions of the courts, and will not to-day reissue a patent for the purpose of broadening claims. The only exception to this statement of the law and the practice is that where an inventor mistakes the scope of his invention, and *immediately on discovery thereof* applies for a reissue, he may obtain a valid reissue patent with the broad claims to which he is entitled. Investors in patent property now well understand that they will ever be restricted to such protection as is granted in the original patent, and the careful first draught and the proper wording of the claims to protect *all there is in the invention* may become of very great monetary value to the patentee. In the patent practice of to-day there is but one safe rule—to prepare the specification and claims as a *finality* (excepting, of course, amendments required by the Patent Office) which can never

after be altered or amended in the manner of enlarging the protection conferred by the patent. For such draughts of the specifications and claims the most careful and intelligent work of the attorney is required. The owner of the invention should satisfy himself that such work is done for him.

I respectfully refer to the following gentlemen :

HENRY C. MEYER, Esq., editor of *The Engineering and Building Record*, of New York.

THOMAS E. BROWN, Esq., the New York Stock Exchange.

C. F. FROTHINGHAM, Esq., President of the Universal Lock Company of New York.

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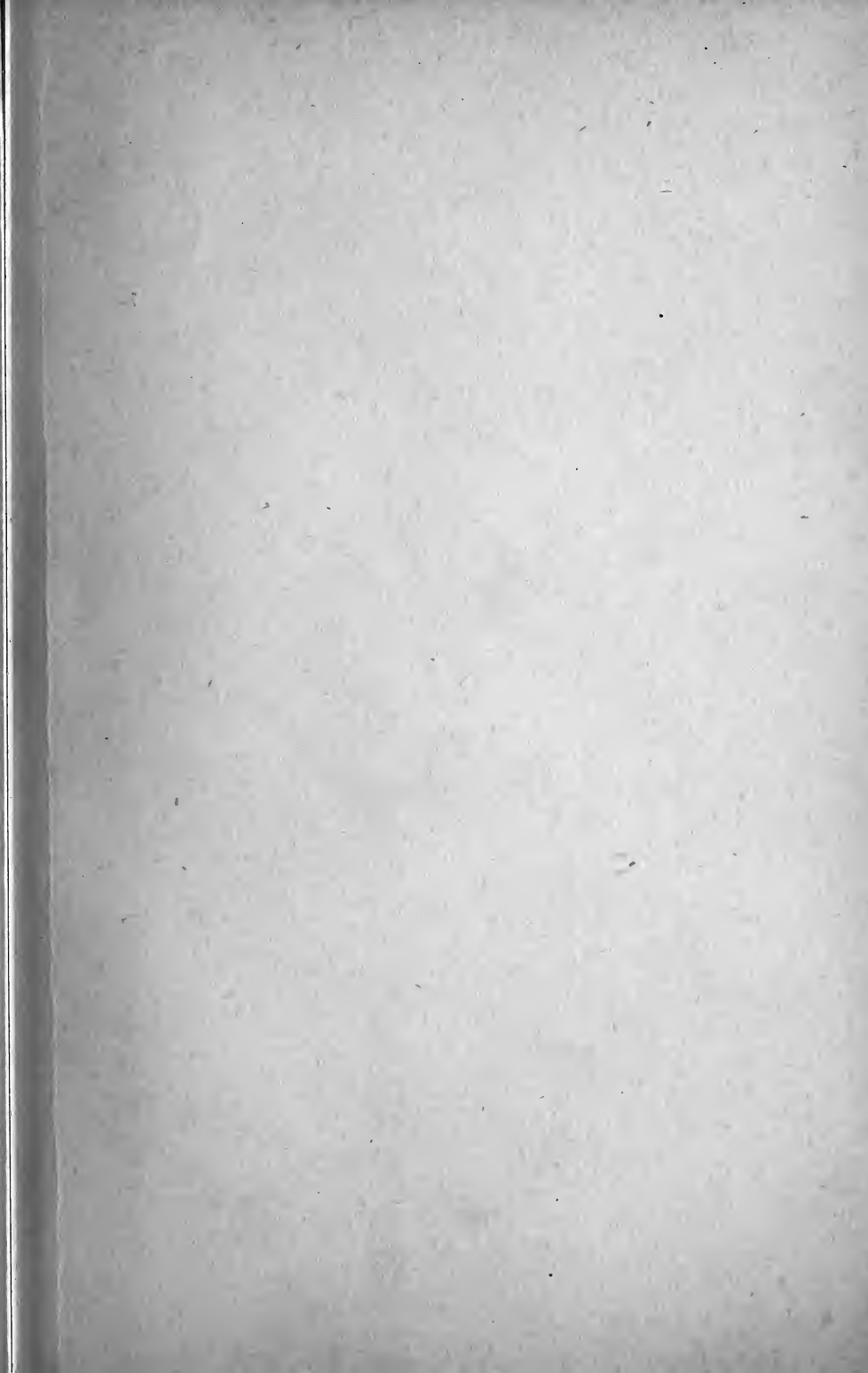
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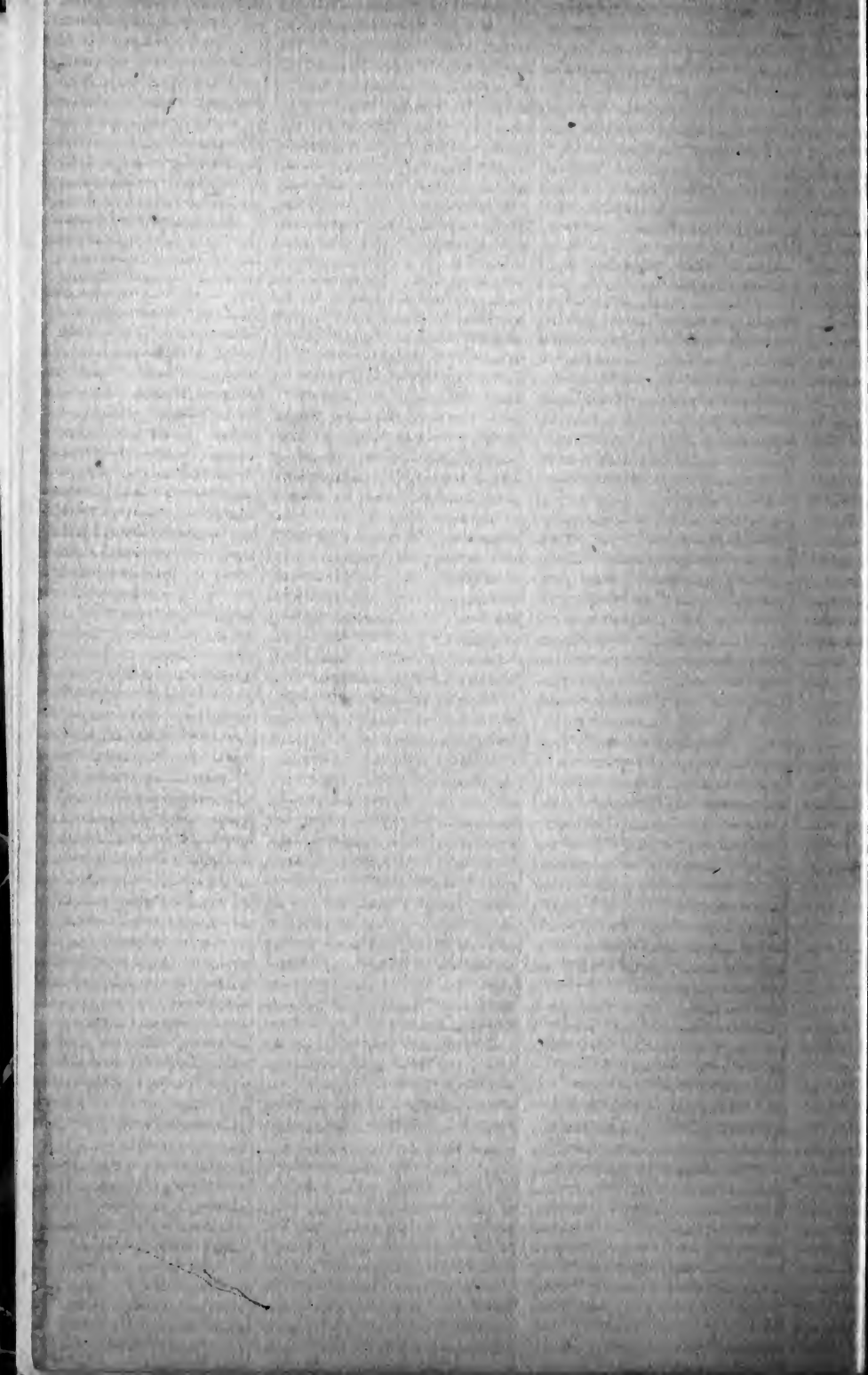
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Respectfully,

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